

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed June 6, 2005. Reconsideration and allowance of the application and presently pending claims 1-8 and 10-28 are respectfully requested.

1. Response to Rejection of Claims 1-27 Under 35 U.S.C. § 102(b)

In the Office Action, claims 1-27 stand rejected under 35 U.S.C. § 102(b) as allegedly being unpatentable by *Tonkin* (U.S. Patent No. 6,134,568). For a proper rejection of a claim under 35 U.S.C. Section 102, the cited reference must disclose all elements/features/steps of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claim 1

As provided in independent claim 1, Applicants claim:

A method comprising:
receiving, via at least one network service, imaging data that is to be included in a booklet;
receiving, via said at least one network service, user input for incorporating the imaging data into the booklet;
building, via said at least one network service, a booklet incorporating imaging data in accordance with said user input; and
printing the booklet on a network-accessible printer designated by user input.

(Emphasis added).

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "printing the booklet on a network-accessible printer designated by user input," as recited and emphasized above in claim 1.

Rather, *Tonkin* discloses at most a system "for providing a way for a user to preview an image of a document before ordering it," where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations. . . . After determining which document production location should receive a particular order, processing facility 60 routes a message addressed to that document production location." Cols. 3-4, lines 59-2 and col. 14, lines 37-40. Further, "whether a location is appropriate for processing an order might merely

mean whether the location is capable of producing the document, but more often will mean more than mere capability, such as indicating whether the location normally handles such work or can readily handle such work. . . . Alternatively, the routing decision may be based on any combination of a capabilities factor and geographic distance to the recipient's location." Cols. 13-14, lines 65-11.

Thus, *Tonkin* fails to teach or suggest "printing the booklet on a network-accessible printer designated by user input." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 1. Hence, claim 1 is not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone.

b. Claims 2-9

Because independent claim 1 is allowable over the cited art of record, dependent claims 2-8 are allowable as a matter of law, for at least the reason that the dependent claims contain all the features and steps of independent claim 1. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). For at least this reason, the rejections of claims 2-8 should be withdrawn.

Additionally and notwithstanding the foregoing allowability of claims 2-8, these dependent claims recite further features and/or combinations of features (as are apparent by examination of the claims themselves) that are patentably distinct from the cited art of record. Hence, there are other reasons why these claims are allowable.

Also, claim 9 has been canceled without prejudice, waiver, or disclaimer. Applicants reserve the right to present this canceled claim, or variants thereof, in continuing applications to be filed subsequently

c. Claims 10-13

As provided in independent claim 10, Applicants claim:

One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

send content to a client device for execution by a client browser, said content enabling the client device to:

display a user interface that is configured to enable a user to select imaging data for use in building a booklet;

provide, over a network, a user selection of imaging data for use in building the booklet;

provide, over the network, user input for incorporating the imaging data into the booklet; and

provide, over the network, user input for designating a network location for printing the booklet.

(Emphasis added).

Applicants respectfully submit that independent claim 10 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature to "provide, over the network, user input for designating a network location for printing the booklet," as recited and emphasized above in claim 10.

Applicants respectfully submit that independent claim 1 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "printing the booklet on a network-accessible printer designated by user input," as recited and emphasized above in claim 1.

Rather, *Tonkin* discloses at most a system "for providing a way for a user to preview an image of a document before ordering it," where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations. . . . After determining which document production location should receive a particular order, processing facility 60 routes a message addressed to that document production location." Cols. 3-4, lines 59-2 and col. 14, lines 37-40. Further, "whether a location is appropriate for processing an order might merely mean whether the location is capable of producing the document, but more often will mean more than mere capability, such as indicating whether the location normally handles such work or can readily handle such work. . . . Alternatively, the routing decision may be based on any combination of a capabilities factor and geographic distance to the recipient's location." Cols. 13-14, lines 65-11.

Thus, *Tonkin* fails to teach or suggest "provid[ing], over the network, user input for designating a network location for printing the booklet." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 10. Hence, claim 10 is not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone. Further, claims 11-13 are allowable for at least the reason that claims 11-13 contain all the features and elements of independent claim 10.

d. Claims 14-17

As provided in independent claim 14, Applicants claim:

A method comprising:

causing, via at least one Web service, a user interface to be presented on a client device, the user interface being configured to enable a user to select imaging data for use in making a booklet;

receiving, via said at least one Web service, a user selection of imaging data;

receiving, via said at least one Web service, user input for incorporating the imaging data into a booklet;

building, via said at least one Web service, a booklet incorporating imaging data received from said user input; and

printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user.

(Emphasis added).

Applicants respectfully submit that independent claim 14 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user," as recited and emphasized above in claim 14.

Rather, *Tonkin* discloses at most a system where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations" without user input or designation. *See* cols. 3-4, lines 59-2; col. 14, lines 37-40; and cols. 13-14, lines 65-11. Thus, *Tonkin* fails to teach or suggest "printing, via said at least one Web service, the booklet on a Web-accessible printer designated by the user." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 14. Hence, claim 14 is not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone. Further, claims 15-17 are allowable for at least the reason that claims 15-17 contain all the features and steps of independent claim 14.

e. Claims 18-21

As provided in independent claim 18, Applicants claim:

A method comprising:

receiving, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receiving, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and
building, via said at least one Web service, a booklet incorporating imaging data received from said user input.

(Emphasis added).

Applicants respectfully submit that independent claim 18 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "receiving, via said at least one Web service, user input for designating a network device for printing the booklet," as recited and emphasized above in claim 18.

Rather, *Tonkin* discloses at most a system where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations" without user input or designation. See cols. 3-4, lines 59-2; col. 14, lines 37-40; and cols. 13-14, lines 65-11. Thus, *Tonkin* fails to teach or suggest "receiving, via said at least one Web service, user input for designating a network device for printing the booklet." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 18. Hence, claim 18 is not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone. Further, claims 19-21 are allowable for at least the reason that claims 19-21 contain all the features and steps of independent claim 18.

f. Claim 22

As provided in independent claim 22, Applicants claim:

One or more computer-readable media having stored thereon computer-readable instructions which, when executed by one or more processors, cause the processors to:

receive, via at least one Web service, a user selection of imaging data that is to be used to build a booklet;

receive, via said at least one Web service, user input for incorporating the imaging data into the booklet;

receiving, via said at least one Web service, user input for designating a network device for printing the booklet; and

build, via said at least one Web service, a booklet incorporating imaging data received from said user input.

(Emphasis added).

Applicants respectfully submit that independent claim 22 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "receiving, via

said at least one Web service, user input for designating a network device for printing the booklet," as recited and emphasized above in claim 22.

Rather, *Tonkin* discloses at most a system where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations" without user input or designation. See cols. 3-4, lines 59-2; col. 14, lines 37-40; and cols. 13-14, lines 65-11. Thus, *Tonkin* fails to teach or suggest "receiving, via said at least one Web service, user input for designating a network device for printing the booklet." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 22. Hence, claim 22 is not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone.

g. Claims 23-24

As provided in independent claim 23, Applicants claim:

A booklet-making method comprising:
browsing to a Web-accessible booklet-making service;
specifying to said Web-accessible booklet-making service imaging data that is to be used to make a booklet and how that imaging data is to be used;
constructing, via said Web-accessible booklet-making service, a booklet incorporating the imaging data; and
forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user.

(Emphasis added).

Applicants respectfully submit that independent claim 23 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user," as recited and emphasized above in claim 23.

Rather, *Tonkin* discloses at most a system where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations" without user input or designation. See cols. 3-4, lines 59-2; col. 14, lines 37-40; and cols. 13-14, lines 65-11. Thus, *Tonkin* fails to teach or suggest "forwarding, from said Web-accessible booklet-making service, the booklet to a network printer designated by a user." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 23. Hence, claim 23 and claim 24 (which depends from claim 23) are not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone.

h. Claims 25-27

As provided in independent claim 25, Applicants claim:

A web service comprising:

means, operably associated with the Web, for enabling a user to specify one or more Web-accessible documents for use in building a booklet;

means, operably associated with the Web, for enabling the user to specify one or more pages from the one or more documents and where said one or more pages will reside in the booklet;

means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet; and

means, operably associated with the Web, for building the booklet.

(Emphasis added).

Applicants respectfully submit that independent claim 25 is allowable for at least the reason that *Tonkin* does not disclose, teach, or suggest at least the feature of "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet," as recited and emphasized above in claim 25.

Rather, *Tonkin* discloses at most a system where a "processing facility 60 [] retrieve[s] document order messages sent over the internet 50, process[es] those orders and then distribute[s] them to one of various document product locations" without user input or designation. See cols. 3-4, lines 59-2; col. 14, lines 37-40; and cols. 13-14, lines 65-11. Thus, *Tonkin* fails to teach or suggest "means, operably associated with the Web, for enabling the user to designate a network printer for printing the booklet." Therefore, *Tonkin* does not teach or suggest at least all of the claimed features of claim 25. Hence, claim 25 and claims 26-27 (which depend from claim 25) are not anticipated by *Tonkin*, and the rejection should be withdrawn for at least this reason alone.

2. New Claim 28

Because independent claim 1 is allowable over the cited art of record, claim 28 (which depends from independent claim 1) is allowable as a matter of law for at least the reason that the dependent claim 28 contains all features/steps of independent claim 1. Additionally, the cited art fails to teach or suggest the feature of "prompting a user to choose a network-accessible printer for printing the booklet from a plurality of available network-accessible printers," as recited in claim 28. Hence, there are other reasons why this claim is allowable.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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